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09/883,193	06/19/2001	Bret A. Evans	58647.000002	9929

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EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT PAPER NUMBER

3626

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/883,193

Applicant(s)

EVANS ET AL.

Examiner

Martin A. Gottschalk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 17-33, 36 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-33, 36 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. Claims 1-14, 17-33, 36, and 38 are pending. Claim 38 is new; all others are original.

### ***Election/Restrictions***

2. Non-elected claims 15, 16, 34, 35, and 37 have been cancelled.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 36 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, i.e. a "signal." First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

"The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some

function and produce a certain effect or result." *Corning v. Burden*, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the *Century Dictionary*). Other courts have applied similar definitions. See *American Disappearing Bed Co. v. Arnaelsteen*, 182 F. 324, 325 (9th Cir. 1910), *cert. denied*, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute

and to adopt that interpretation when it re-enacts a statute without change. *Lorillard v. Pons*, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in *American Fruit Growers* when it passed the 1952 Patent Act.

A manufacture is also defined as the residual class of product. 1 Chisum, § 1.02[3] (citing W. Robinson, *The Law of Patents for Useful Inventions* 270 (1890)). A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture.

Thus, a signal does not fall within one of the four statutory classes of § 101.

### ***Claim Rejections - 35 USC § 112***

5. The rejection under this section is hereby withdrawn.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-14, 17-33 rejected under 35 U.S.C. 102(e) as being anticipated by Chapman et al (US Pat# 6,526,386, hereinafter Chapman).

A. As per claim 1, Chapman discloses a system for facilitating interaction with an insurance service, comprising:

a processor unit for executing program instructions Chapman: col 3, Ins 50-61; Fig 1, e.g. items 124 and 146 for example.);

a memory, coupled to the processor unit, for storing the program instructions (Chapman: col 4, Ins 3-10; Fig 1, e.g. item 124 for example.);

a communication interface, coupled to the processor unit, for interacting with a user (Chapman: Fig 1, item 104 for example);

and

interface logic for providing a graphical interface presentation to the user concerning the insurance service (Chapman: col 3, ln 50 to col 4, ln 2), including at least one of:

(a) a first dashboard display for presenting overview information with respect to the renewal of at least one insurance policy (Chapman: col 4, lns 52-58; Figs 3 to 5);

(b) a second dashboard display for presenting overview information with respect to the processing of at least one automatic agreement (Chapman: col 5, ln 49 to col 6, ln 14; col 6, lns 22-45; Fig 6).

B. As per claim 3, Chapman discloses the system of claim 1, wherein

the interface logic includes at least two of the first through fourth dashboard displays (rejected as per claim 1).

C. As per claims 17 and 18, they are claims drawn to a computer readable medium for providing instructions to processing logic which repeat the same limitations of claims 1 and 3, the corresponding system claims, as a series of instructions as opposed to a collection of elements. Since the teachings of Chapman disclose the structural elements that constitute the system of claims 1 and 3, it is respectfully submitted that they perform the underlying instructions, as well. As such, the limitations of claims 17 and 18 are rejected for the same reasons given above for claims 1 and 3.

D. As per claims 20-22, and 33, they are method claims which repeat the same limitations of claims 1-3, and 14 the corresponding system claims, as a series of process steps as opposed to a collection of elements. Since the teachings of Chapman disclose the structural elements that constitute the system of claims 1-3, and 14, it is respectfully submitted that they perform the underlying process steps, as well. As such, the limitations of claims 20-33, and 33 are rejected for the same reasons given above for claims 1-3, and 14.

E. Claim 36 is a computer instructions claim performing the steps of claim 20 and is thus rejected for the same reasons as claim 20.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



10. Claims 4-13, 19, and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman.

A. As per claims 4-13, Chapman teaches a system that provides a graphical user interface populated with a plurality of fields broadly concerning the various types of information associated with an insurance service (see rejection for claim 1).

Chapman fails to explicitly teach the specific fields recited in claims 4-13.

However, the differences between these claims and the prior art are found only in the specific data selected for display regarding the insurance service. This is non-functional descriptive material and will not distinguish the claimed invention from the prior art in terms of patentability, see Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include selecting different types of insurance related information to display as a matter of design choice. *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

B. As per claim 19, it is a claim drawn to a computer readable medium for providing instructions to processing logic which repeats the same limitations of claim 12, the corresponding system claim, as a series of instructions as opposed to a collection of elements. Since the teachings of Chapman disclose the structural elements that constitute the system of claim 12, it is respectfully submitted that they perform the underlying instructions as well. As such, the limitations of claim 19 are rejected for the same reasons given above for claim 12.

The motivation for incorporating the features of Chapman is as given above in the rejection of claims 4-13, and is incorporated herein.

C. As per claims 23-32, they are method claims which repeat the same limitations of claims 4-13, the corresponding system claims, as a series of process steps as opposed to a collection of elements. Since the teachings of Chapman disclose the structural elements that constitute the system of claims 4-13 it is respectfully submitted that they perform the underlying process steps, as well. As such, the limitations of claims 23-32 are rejected for the same reasons given above for claims 4-13.

The motivation for incorporating the features of Chapman is as given above in the rejection of claims 4-13, and is incorporated herein.

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11. Claims 2, 14, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman as applied to claim 1 above, and further in view of Underwood et al (US Pat# 5,873,066).

A. As per claim 2, Chapman suggests (Chapman: col 3, Ins 34-37) but fails to explicitly disclose the features of claim 2 which are disclosed by Underwood who teaches the system of claim 1, wherein

the insurance service comprises a reinsurance service (Underwood: col 6, Ins 38-46; Fig 13).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of Underwood into the system of Chapman with the motivation of allowing an insurance agent to ensure that all relevant information pertaining to an insurable risk is properly documented (Underwood: col 1, Ins 53-64) thus further enabling the agent to generate renewal policies with a minimum of interaction with insurance carrier personnel (Chapman: col 1, Ins 36-39).

**Note:** In subsequent rejections incorporating the teachings of Chapman and Underwood, the same motivation applies as provided above for claim 2 above and will not be repeated.

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B. As per claim 14, Chapman discloses the system of claim 1, further including

a database that identifies a user group assigned to the user, and wherein the interface logic includes logic for selecting information for display in the at least one dashboard display based on the user's assigned group (Underwood: col 7, lns 17-30; Fig 5, i.e. the database identifies the group of producers capable of countersigning a contract. Note that the user is a member of this group.).

C. As per claim 38, Chapman fails to explicitly disclose the features of the claim which are disclosed by Underwood, who teaches the system of claim 1, wherein

each dashboard display is displayed in conjunction with a respective tab associated with the displayed dashboard display, the respective tab being displayed along with other tabs associated with other dashboard displays (Underwood: Fig 6 for example, note the tabs denoting "Reinsurance," "Policy," etc.).

### ***Response to Arguments***

12. Applicant's arguments with respect to claim 1 regarding the insufficiency of the relied upon Ruggieri provisional application to support the rejections have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Thurs 8:30 -6 and alternate Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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09/12/2006



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PATENT EXAMINER